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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/696,538	10/25/2000	Timothy Redpath	20563-000100US	3091

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EXAMINER

DASS, HARISH T

ART UNIT PAPER NUMBER

3628

DATE MAILED: 09/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/696,538

Applicant(s)

REDPATH ET AL.

Examiner

Harish T Dass

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*[Handwritten signature]*

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 16 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Objections***

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-9 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The amended claim 1 introduces new matters such as: "predetermined portfolio" claim 1 line 7 (the closes phrase Examiner can find in specification is predefined portfolio, page 3 line 16 of specification) and "adjust the value" claim 1 lines 6-7 (the closes phrase Examiner can find in specification is ... user database 112 to be updated as a result of transactions ..., page 6 lines 20-21). applicant is required to show where these matters are shown in original specification or remove them.

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

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Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "adjust the value" and "predetermined portfolio" in lines 6-7. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mosler et al.

(US Patent No. 6,304,858) in view of Rebane (US Patent No. 6,078,904) and Geoff Smith, "Computer games 'Markets' bonds fun and finance", Boston Herald. Boston, Mass.: Oct 11, 1992. pg. 067. (hereinafter Smith).

Re. Claim 1, Mosler discloses methods and software products for financial analysis risk management, investment portfolio design and the selection, analysis of investments and the allocation of investment assets among investments [see entire document particularly Abstract; C1 L5 to C5 L5], setting up an account representing a predefined portfolio

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(traded contracts) of nonzero value (account deposit) for each of a plurality of participants [C5 L15-L56; C6 L37 to C7 L8; C27 L38-L42; C30 L42-L53], accepting trades from the plurality of participants [C8 L22-L36; C14 L5-L21]. However, Mosler does not explicitly disclose awarding each participant an amount that is a function of their portfolio's performance over an investment period, and applying the trades to the portfolios of the trader participants to thereby adjust the value of predetermined portfolio. However, Rebane discloses awarding each participant an amount that is a function of their portfolio's performance over an investment period [C8 L6-L36; C21 L3-L52] to profit from sale. Further, Smith discloses electronic simulation trading games SMG400 and SMG2000, applying the trades to the portfolios of the trader participants to thereby adjust the value of predetermined portfolio (stocks can be bought or sold) to make more money. Additionally, it is known that to open an account requires initial deposit. Therefore, it would be obvious to one having ordinary skill in the art at the time the invention was made to use that step in the Mosler invention. One would be motivated to use that step in order to compensate the investor risk.

Re. Claim 2, Mosler discloses wherein the step of setting up an account is a step of setting up an account with a portfolio of a predefined cash amount [C1 L65 to C2 L61; C3 L60-L63; C4 L38-L61; C5 L26-56; C7 L23 to C9; L14; C9 L35 to C10 L65; C11 L13 to C12 L51; C12 L57-L62; C13 L9-L34; C12 L60 to C14 L43; C14 L64 to C16 L8; C18 L58 to C19 L51; C20 L14-L24; C20 L34-61; C21 L7-L63].

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Re. Claim 3, Mosler does not explicitly disclose wherein an amount awarded at the end of the investment period is all of the net profits the participant made during the investment period. However, Rebane also discloses wherein an amount awarded at the end of the investment period is all of the net profits the participant made during the investment period [Fig. 7; C15 L21-L29; C38 L35-L67] to expect a return for the portfolio given the allocation of the investment funds among the investments.

Therefore, it would be obvious to one having ordinary skill in the art at the time the invention was made to use that step in the Mosler, Rebane and Smith invention. One would be motivated to use that step in order to compensate the investor risk.

Claims 4-5: Mosler does not explicitly disclose wherein an amount awarded at the end of the investment period is a percentage of less than 100% of the net profits the participant made during the investment period and wherein an amount awarded at the end of the investment period is all of the net profits the participant made during the investment period up to a predetermined maximum award. However, Rebane also discloses wherein an amount awarded at the end of the investment period is a percentage of less than 100% of the net profits the participant made during the investment period [C16 L55 to C17 L7], and wherein an amount awarded at the end of the investment period is all of the net profits the participant made during the investment period up to a predetermined maximum award [C14 L41-L67; C16 L65 to C17 L7] for market performance and market return. Therefore, it would be obvious to one having ordinary skill in the art at the time the invention was made to use that step in the Mosler,

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Rebane and Smith invention. One would be motivated to use that step in order to compensate the investor risk.

Re. Claim 6, Mosler discloses the step of executing trades made by the participants with the traded securities held in the name of a system operator or the participants [C15 L66 to C16 L8].

Re. Claim 7, Mosler discloses the step of offsetting risk to a system operator by one or more of sponsorships, advertising and participant fees [C31 L49-L51].

Re. Claims 8, Mosler discloses the steps of accounting for the trades as if the participants made the trades with some predetermined delay [C16 L54 to C17 L30], executing hedging transactions in response to participant trades [C6 L37 to C7 L8], and wherein the predetermined delay is a delay to the market close [C20 L25-L29].

### ***Response to Arguments***

4. Applicant's arguments with respect to claim 1 have been considered but are moot in view of the new ground(s) of rejection.

In response to applicant's arguments, the recitation simulated trading has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the

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claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

### ***Conclusion***

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Applicant is required under 37 CFR ' 1.111 (c) to consider the references fully when responding to this action.



*NEILL, Mar 11, 1999, "Students profit from investment game Series" discloses five Deltona Elementary School fourth-graders cruised through their portfolio of stock picks like seasoned professionals. Huddled around their classroom computer, they examined the daily stock quotes, summaries and recent history of each of their corporate choices before making their decision to buy or stay put.*

*John, Dec. 29, 1998, "Dealing a share of reality: TECHNOLOGY COMPUTER GAMES" discloses a PC-based stock market simulator game that combines genuine scenarios and bolted-on video clips. The PC-based stock market simulator game let people have entertainment but also make people realize that inflation has an influence on interest rates, which have an influence on employment, which has an influence on growth, which has an influence on policy etcetera.*

*Amy Joyce, Apr. 1, 1999 "Students Play the Stock Market; Game Takes Classes Through Highs, Lows" discloses a 10-week simulation of Wall Street stock trading, developed by the Securities Industry Association's Foundation for Economic Education. Students in grades 4 through 12 are formed into teams of three to five members and are given an imaginary \$100,000 to invest in the stocks that are listed on the American Stock Exchange, the NASDAQ and the New York Stock Exchange.*

*US 6,317,728 to Kane, Nov. 13, 2001 "Securities and commodities trading system" discloses a securities and/or commodities trading system that includes a computer arrangement communicating with a securities exchange, and has inputs for receiving buy and sell data. The computer arrangement is capable of evaluating the buy/sell data and issuing buy/sell orders in accordance with a plurality of buy/sell rules, i.e. "agents," stored in the system. A feedback arrangement monitors the success and failure of the respective*

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*buy/sell agents and assigns rating powers, i.e. weightings, to the buy/sell agents in order to implement a learning process for gradually improving the system performance based on past and continuously accumulating experience of the agents.*

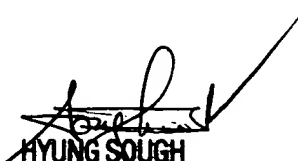
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Harish T Dass whose telephone number is 703-305-4694. The examiner can normally be reached on 8:00 AM to 4:50 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung S Sough can be reached on 703-308-0505. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Harish T Dass  
Examiner  
Art Unit 3628

9/14/04

  
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